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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,578	06/04/2001	Roger Flores	PALM-3644.US.P	5683

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EXAMINER	
PATEL, HARESH N	

ART UNIT	PAPER NUMBER
2154	7

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/874,578	Applicant(s) FLORES ET AL.	
	Examiner Haresh Patel	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 June 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are presented for examination.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The present title is not sufficient for proper classification of the claimed subject matter.

Drawings

3. Applicant submitted modified figures 2 and 6 are acknowledged. Applicant is requested to submit the formal drawings.

Response to Amendments

4. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendments to the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, are rejected under 35 U.S.C. 102(e) as being anticipated by Choate "Method of and system for monitoring an application", US 2001/0054026 A1, Dec. 20, 2001.

7. As per claim 1, Choate teaches the following:

a method of automatically tracking content usage (e.g., use of Beacon Application for content monitoring method, abstract, paragraph 9, col., 1, audio/video contents, paragraph 31, col., 3) comprising the steps of:

a) accessing a first program call (e.g., APIs of the Beacon Application, paragraph 26, col., 3) having a parameter identifying (e.g., API identifier, paragraph 26, col., 3), a first portion of content whose usage is to be measured for content related to the calling program (e.g., Upon activation of the Tagged Applications utilizing the Application Key, the Beacon within Tagged Application 19 transmits Application Information to Application Metering Module 22, paragraph, 21, col., 2);

b) in response to said first program call, measuring usage for said first portion of content (e.g., tracking of segments of audio/video contents, paragraph 31, col., 3); and

c) repeating said steps a) and b) for additional portions of content to be measured, wherein content usage is tracked for a plurality of portions of content identified by a plurality of program calls (e.g., subsequent API calls having API identifiers to monitor audio/video contents, paragraphs 4 and 5, col., 1, paragraph 31, col., 3).

8. As per claim 3, Choate teaches the following:

said portions of content are segments in an electronic document (e.g., segments of a content file, abstract).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Choate in view of Bezick et al. 5,746,656 (Hereinafter Bezick).

11. As per claim 2, Choate teaches the claimed limitation as rejected under claim 1. Choate also mentions that the portions of the contents can be any data. However, Choate does not specifically mention about the portions of content are levels of a game. It is well-known in the prior art, for example, Bezick teaches portions of content are levels of a game, which can be tracked, col., 1, lines 19-34, col., 2, lines 43 – 58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Choate with the teachings of Bezick in order to facilitate monitoring of the game levels. The tracking of the game levels would provide how the game performs, as suggested by Bezick.

12. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choate in view of Nakajima et al. 6,442,699 (Hereinafter Nakajima).

13. As per claims 4 and 5, Choate teaches the claimed limitation as rejected under claim 1. Choate also mentions about automatic tracking of each content usage of a content/video file using API calls and API identifiers. However, Choate does not specifically mention about the use of program calls to specifically indicate begin, end and stop of the portion of content. It is well known in the prior art, for example, Nakajima teaches the use of program calls to indicate begin, end and stop of the content portion (e.g., API calls to start, end, terminate video image, etc., figure 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Choate with the teachings of Nakajima in order to facilitate monitoring the portions of the content file using API calls at the begin, end and stop of the content portion. The API calls at begin, end and stop of the content portion would provide keeping track of when the content portion starts, when the content portion ends and when the content portion stops. The information of when the content portion starts, when the content portion ends and when the content portion stops would help monitor the time taken by each content portion which can be provided to the user, as suggested by Nakajima.

14. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choate, Nakajima in view of "Official Notice".

15. As per claims 6-8, refer to the above-mentioned rejection of claims 4 and 5, for the limitations other than "use of measuring the number of processor cycles elapsed and content usage indicator describing the percent of content portion utilized", taught by combination of Choate and Nakajima. However, Choate and Nakajima do not specifically mention about the use

of measuring the number of processor cycles elapsed and content usage indicator describing the percent of content portion utilized. "Official Notice" is taken that both the concept and advantages of providing to measure the number of processor cycles elapsed and content usage indicator describing the percent of content portion utilized is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include measuring the number of processor cycles elapsed and content usage indicator describing the percent of content portion utilized with the teachings of Choate and Nakajima in order to facilitate a mechanism to calculate the amount of time taken by each content portion and content usage indicator describing the percent of content portion utilized. The information of time taken by each content portion and the information of the percentage amount of content portion utilization would be used by the monitoring application for producing statistic results for the user.

16. Claims 9 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choate in view of "Official Notice".

17. As per claim 9, Choate teaches the claimed limitation as rejected under claim 1. Choate also teaches storing content usage data for each of plurality of portions of content and transferring usage data to a repository for reporting (e.g., usage of modules of the server to store segments of the content/video file, paragraph 30, col., 3). However, Choate do not specifically mention about tabulating the usage data. "Official Notice" is taken that both the concept and advantages of tabulating the usage data is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include tabulating the usage data with the teachings of Choate in order to facilitate a mechanism to organize the collected usage data. The queries to the organized usage data will become simpler to generate statistic results for the user.

18. As per claims 10-13, Choate teaches the claimed limitation as rejected under claim 1. Choate also teaches storing content usage data and transferring usage data to a repository (e.g., usage of modules of the server to store segments of the content/video file, paragraph 30, col., 3), a plurality of devices executing a software program (e.g., application has been used on a workstation or group of workstations, paragraph 20, col., 2). However, Choate do not specifically mention about a software program having a plurality of versions and whether merging or not merging the collected usage data for same versions of the software. "Official Notice" is taken that both the concept and advantages of a software program having a plurality of versions and whether merging or not merging the collected usage data for same versions of the software is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a software program having a plurality of versions and whether merging or not merging the collected usage data for same versions of the software with the teachings of Choate in order to facilitate collecting and organizing usage data of a software program having multiple versions. The usage data of each version of the software will be merged to represent the usage data for the software itself regardless of its versions. The total usage data of the same software will be used to represent statistic results to the user.

19. As per claims 14 and 15, these claims are rejected as per claims 9-13. Choate teaches usage data describe the amount of content associated with said software program was used during an execution of said program (e.g., usage of the content file segments while execution of each individual segment, paragraph 20, col., 2). Choate also teaches usage data describe information selected from the group consisting of the number of times said software program was executed and the amount of time for which said software program was executed, e.g., number of times the application is run and for the time the application is run, paragraph, 10, col., 2).

20. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. 5,796,952 (Hereinafter Davis) in view of applicant's admitted prior art (AAPA), as disclosed in the non-final action paper number 2, mailed on 10/27/03.

Response to Arguments

21. Applicant's arguments for claims 16-20, filed 10/8/03 have been fully considered but they are not persuasive.

Applicant argues (1) Davis in view of applicant's admitted prior art do not disclose "accessing a call from a software program, said call specifying a first content identifier, said first content identifier identifying content related to said software program whose usage is to be measured". The examiner disagrees in response to applicant's arguments. Davis teaches a server collecting content usage data of different applications from a tracking program, which accesses

interaction from the interactive game and multimedia applications whose usage is to be measured. Interactive game and multimedia applications provide their contents information while they are running. Also, different types of applications are identifiable by the tracking program and the server collecting content usage data of the applications, e.g., col., 1, lines 32 – 43, 55 – 63, col., 4, lines 1-63, col., 5, lines 4-13, figure 5. It is well known in the prior art; for example, applicant's admitted prior art discloses use of call between two entities, e.g., page 1, lines 23-24 of the specification. Hence, using call, the server collecting content usage data of the applications call gather contents of the application through the tracking program. Therefore the rejection in maintained as disclosed above.

Applicant argues (2) Davis in view of applicant's admitted prior art do not disclose "the application program to place an API calls that defines what content is to be measured for the calling application". The examiner disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the application program to place an API calls that defines what content is to be measured for the calling application") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As disclosed above, the combination of Davis in view of applicant's admitted prior art teaches the call specifying a content identifier identifying content related to the software program whose usage is to be measured. Therefore the rejection in maintained as disclosed above.

Applicant argues (3) Davis in view of applicant's admitted prior art do not disclose "the application program to place program calls that defines what content is to be measured for the

calling application". The examiner disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the application program to place program calls that defines what content is to be measured for the calling application") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As disclosed above, the combination of Davis in view of applicant's admitted prior art teaches the call specifying a content identifier identifying content related to the software program whose usage is to be measured. Therefore the rejection in maintained as disclosed above.

Conclusion

22. Examiner makes a note that cited Reference, "User-side tracking of multimedia application usage within a web page", Pub. No. US 2003/0046385 A1, Mar. 6, 2003, Marcus Vincent, clearly teaches the applicant's claimed subject matter. Applicant submitted IDS, Application Usage version 0.6 – 0.8.1, Benc Software Production also teaches "application usage" software that teaches the applicant's claimed subject matter.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (703) 605-5234. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Haresh Patel

May 6, 2004

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100